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09/830,082	04/20/2001	George H. Kramer	1197.001US3	9707

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EXAMINER

ODLAND, KATHRYN P

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 09/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/830,082

Applicant(s)

KRAMER, GEORGE H.

Examiner

Kathryn Odland

Art Unit

3743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-12, 15-26 and 28-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-12, 15-26 and 28-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 3743

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: SC. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

A novel feature of the invention should be included in the title.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-6, and 15-18 are rejected under 35 U.S.C. 102(a and/or e) as being anticipated by Pinter in US Patent No. 6,277,142.

Regarding claim 1, Pinter discloses an acupressure device for use on a selected skin surface portion of a human body having:

- A thin flexible base (such as 32) having a first side, a second side and a margin, the margin having at least a portion shaped as an orienting margin, *wherein the orienting margin is shaped to correspond to a shape on or adjacent to the selected skin surface portion when the base sheet is placed on the selected body surface*, as stated in column 11, lines 42-67, column 12 and seen in figures 1A-5. Further, as seen in figure 2 the shape and orientation of element 20 is shaped to correspond to particular placement (Additionally, “wherein” statements are not given patentable weight since they are considered to be “[l]anguage that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure [and therefore] does not limit the scope of a claim or claim citation” (See M.P.E.P. 2106, page 2100-7, Rev. 2, July 1996))
- An adhesive layer (34) on the first side of the base sheet suitable for attaching the base sheet to the selected skin surface portion, as recited in column 11, lines 43-67 and 40-55
- At least one bead (22, 24, 26, 28, 30) on the adhesive layer suitable for positioning against the selected body surface for providing acupressure to at least a portion of the selected body surface

Art Unit: 3743

Regarding claim 2, Pinter discloses a flexible base sheet that is a synthetic polymeric film, synthetic polymeric fibers in a woven fabric, or natural fibers in a woven fabric, as recited in column 10, lines 10-18

Regarding claim 3, Pinter discloses a bead that is a metal or metal alloy, as recited in column 7, lines 65-67 and column 8, lines 1-15

Regarding claim 4, Pinter discloses a metal or metal alloy that is selected from the group of iron, titanium, stainless steel, nickel, copper, tin, zinc, platinum, gold, and silver, as recited in column 7, lines 65-67 and column 8, lines 1-15

Regarding claim 5, Pinter discloses at least one bead that is a polymeric compound, a ceramic compound, a glass compound, or a rubber compound, as recited in column 7, lines 65-67 and column 8, lines 1-15

Regarding claim 6, Pinter discloses a base sheet that further has a tab (such as 48), suitable to wrap around a portion of the body adjacent to the selected skin surface and adhesive when the device is applied, thus providing compression which increases the contact between the body surface and the at least one bead, as recited in column 11, lines 43-67, column 12, and seen in figures 1A-5

Regarding claim 15, Pinter discloses a method for applying pressure to one or more selected points on a selected skin surface point of a human body via aligning an orienting margin of the device with a corresponding shape on or adjacent to the skin surface portion, conforming the shape of the device to the intended site of adhesion and causing adhesion of the device, wherein the adhesion of the device results in the application of pressure to the selected points, as stated in columns 13-14 and seen in figures 1A-5

Regarding claim 16, Pinter discloses correcting an energy flow imbalance in a human via applying the device of claim 1 to an acupressure point on the skin of a human, as recited throughout the specification

Regarding claim 17, Pinter discloses producing a sense of well being in a human via applying the device of claim 1 to an acupressure point on the skin of a human, as discussed throughout the specification

Regarding claim 18, Pinter discloses treating a condition selected from headache, premenstrual syndrome, stress, anxiety, muscular-skeletal pains, allergies, nausea, pain, menstrual cramps, low back pain, dental analgesia and depression, in a human via applying the device of claim 1, as stated in column 13, lines 50-67 and column 14, lines 1-10

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7, 8, 10-12, 19-26 and 28-30 rejected under 35 U.S.C. 103(a) as being unpatentable over Pinter in US Patent No. 6,277,142.

Pinter discloses the invention with the exception of explicitly reciting:

- A skin surface portion of a human that is the tragus, wherein the orienting margin is shaped to correspond to the front of the tragus when the base sheet is placed on the selected body surface
- A release film
- A packing material and instructions for use
- One or more pictures illustrating how to align the orienting margin with the shape on or adjacent to the selected skin surface
- A method for promoting weight loss
- A method for promoting smoking cessation
- Applying external pressure one or more times to the device on the skin
- Applying external pressure to the device when a symptom of a condition worsen
- Applying external pressure to the device to alleviate the desire to eat
- Applying external pressure to the device to alleviate the desire to smoke

Art Unit: 3743

- External pressure that is applied by pinching the device against the skin surface portion
- External pressure that is applied multiple times over a period of hours
- A skin surface that is an antitragus and wherein the orienting margin is shaped to correspond to the base of the antitragus when the sheet is placed on the selected body surface
- A selected skin surface that is an antitragus where the device has an accessory lobe to an adjacent therapy point and where the orienting margin is shaped to correspond to the base of the antitragus when the base sheet is placed on the selected body surface
- An adjacent therapy point that is on the inner surface of the pinna

On the other hand, a skin surface portion of a human that is the tragus, wherein the orienting margin is shaped to correspond to the front of the tragus when the base sheet is placed on the selected body surface; a skin surface that is an antitragus and wherein the orienting margin is shaped to correspond to the base of the antitragus when the sheet is placed on the selected body surface; a selected skin surface that is an antitragus where the device has an accessory lobe to an adjacent therapy point and where the orienting margin is shaped to correspond to the base of the antitragus when the base sheet is placed on the selected body surface; and an adjacent therapy point that is on the inner surface of the pinna would be obvious to one with ordinary skill in the art. The ear has numerous known acupuncture points that are well known in the art.

Thus, configuring the device to be shaped such that it can be placed in the ear would be obvious to one with ordinary skill in the art. Given the unique and strange shape of the ear, it would be obvious to one with ordinary skill in the art to modify the invention of Pinter to be shaped such that it can be placed in the acupressure points in the ear.

Furthermore, release film; packing material and instructions for use; and one or more pictures illustrating how to align the orienting margin with the shape on or adjacent to the selected skin surface would also be obvious to one with ordinary skill in the art.

Moreover, acupressure is well known for promoting weight loss and promoting smoking cessation. Therefore, it would be obvious to one with ordinary skill in the art to modify the invention of Pinter for use in the ear, which would correspond to promoting weight loss and smoking cessation. Additionally, although not explicitly recited, applying external pressure one or more times to the device on the skin; applying external pressure to the device when a symptom of a condition worsen; applying external pressure to the device to alleviate the desire to eat; applying external pressure to the device to alleviate the desire to smoke; external pressure that is applied by pinching the device against the skin surface portion; and external pressure that is applied multiple times over a period of hours would also be obvious to one with ordinary skill in the art for it is known to use pressure in acupressure.

Double Patenting

7. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re*

Art Unit: 3743

Ockert, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

8. Claim 1 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 6,261,306. This is a double patenting rejection.

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-8, 10-12, 15-26, and 28-30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,030,408. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are merely a reworded representation for the same subject matter, perhaps a bit broader in some aspects while a bit narrower in others.

11. Claims 2-8, 10-12, 15-26, and 28-30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-18 of U.S. Patent No. 6,261,306. Although the conflicting claims are not identical, they are

Art Unit: 3743

not patentably distinct from each other because they are merely a reworded representation for the same subject matter, perhaps a bit broader in some aspects while a bit narrower in others.

12. Claims 1-8, 10-12, 15-26, and 28-30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-44 of U.S. Patent No. 6,458,146. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are merely a reworded representation for the same subject matter, perhaps a bit broader in some aspects while a bit narrower in others.

13. Claims 1-8, 10-12, 15-26, and 28-30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 10/229,902. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are merely a reworded representation for the same subject matter, perhaps a bit broader in some aspects while a bit narrower in others.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are as follows: US 2003/0139698; US Patent No. 6,299,586; US Patent No. 6,050,931; US Patent No. 5,944,740; US Patent No. 4,841,647; and US Patent No. 3,595,225.

Art Unit: 3743

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathryn Odland whose telephone number is (703) 306-3454. The examiner can normally be reached on M-F (7:30-5:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A Bennett can be reached on (703) 308-0101. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

KO



Henry A Bennett
Supervisory Patent Examiner
Group 3700